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Paper No. 21
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cerner Corporation

Serial No. 75/151,569

William B. Kircher and Timothy C. Bickham of Shook, Hardy & Bacon L.L.P. for Cerner Corporation.

Howard Smiga, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Hanak, Hairston and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark HEALTH FACTS, in typed form, for goods identified in the application (as amended) as "computer software for use by healthcare institutions and health care professionals in combining clinical data with claims based billing data and data from public sources."[1]

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[1] Serial No. 75/151,569, filed August 18, 1996. The application is based on applicant's allegation of bona fide intent to use the mark, under Trademark Act Section 1(b).

The Trademark Examining Attorney has refused registration on two grounds, under Trademark Act Sections 2(e)(1) and 2(d). The Section 2(e)(1) refusal is based on the Trademark Examining Attorney's contention that applicant's mark is merely descriptive of the goods identified in the application. The Section 2(d) refusal is based on the Trademark Examining Attorney's contention that applicant's mark, as applied to applicant's goods, so resembles the mark HEALTH FACTS, previously registered on the Supplemental Register for "periodically published news sheet,"[2] as to be likely to cause confusion, to cause mistake, or to deceive.

When the Trademark Examining Attorney made the refusals final, applicant filed this appeal. Applicant and the Trademark Examining Attorney filed main briefs, and applicant filed a reply brief. Applicant initially requested an oral hearing, but subsequently withdrew that request. No oral hearing was held. We reverse the refusals to register.

We turn first to the Section 2(e)(1) mere descriptiveness refusal. A term is merely descriptive of

[2] Supplemental Register Registration No. 1,191,909, issued March 9, 1982, Section 8 affidavit accepted. The registrant is Center for Medical Consumers and Health Care Information Inc.

goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.,* 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.,* 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd*., 204 USPQ 591, 593 (TTAB 1979).

In support of his Section 2(e)(1) refusal, the Trademark Examining Attorney has submitted the following evidence:[3]

(1) Dictionary definition of "health" (Random House Unabridged Dictionary of the English Language (2d Ed. 1987) at 882) attached to the Trademark Examining Attorney's first office action:

> 1. The general condition of the body or mind with reference to soundness and vigor: *good health; poor health*. 2. Soundness of body or mind; freedom from disease or ailment: *to have one's health; to lose one's health*. 3. A polite or complimentary wish for a person's health, happiness, etc., esp. as a toast: *We drank a health to our guest of honor*. 4. Vigor; vitality; *economic health*.

(2) Dictionary definition of "fact" (Webster's II New Riverside University Dictionary (1994) at 460) attached to the Trademark Examining Attorney's first office action:

> 1. Something put forth as objectively real. 2. Something objectively verified. 3.a. Something with real, demonstrable existence <Travel to the moon is now a *fact*.> b. The quality of being real or actual. 4. Something carried out or performed.

[3] We sustain the Trademark Examining Attorney's objection to the listing of third-party registrations submitted by applicant in its Supplemental Request for Reconsideration (and resubmitted as Exhibit A to applicant's reply brief). As the Trademark Examining Attorney has properly noted, third-party registrations may not be made of record merely by listing them; soft copies of the registrations, obtained from the Office's records, are required. *See In re Total Quality Group Inc.,* 51 USPQ2d 1474 (TTAB 1999); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). We accordingly have given this listing of registrations no consideration.

(3) The following "representative sample" of 1,001 excerpted articles retrieved by the search "HEALTH FACTS" from the ALLNWS file of the NEXIS® automated database, attached to the Trademark Examining Attorney's final office action:[4]

> The statistics, compiled last summer, compared health trends in Massachusetts and Somerville specifically. Following are some **health facts** mentioned in the presentation. Somerville death rates are similar to the state's: AIDS deaths and homicides both dropped significantly from 1995 to … (The Boston Globe, November 30, 1997);
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> HEADLINE: How to get every **health fact** you'll ever need (Redbook, November 1997);
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> Recently, Plauka shared some basic dental **health facts**: Teeth, which form during the third and sixth month of pregnancy[,] are affected by the mother's diet. Plaque, a sticky, colorless … (The Virginian-Pilot (Norfolk, VA), October 31, 1997);
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> Once again, the Seafood Board appreciates coverage of the seafood **health facts**, and would like to restate a quote from state health experts regarding the risk that mercury in fish presents. (The Advocate (Baton Rouge, LA), October 18, 1997; identical excerpt from The Times-Picayune, September 26, 1997, also submitted by Trademark Examining Attorney);
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> Breast **health facts**, survivors' stories, news and issues (including an article, "New Hope for Breast Cancer Patients in Need of …") (Chattanooga Free Press, October 12, 1997);

[4] We have not considered two of the excerpts submitted by the Trademark Examining Attorney (story nos. 31 and 40), which are from unpublished wire service reports. *See, e.g., In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987) at n.6, and *In re Men's Int'l Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986) at n.5.

"Cardiovascular **Health Fact** Sheet." Vitamin Nutrition Information Service. Hoffman-la Roche. Nutley, N.J. (Better Nutrition, September 1997);

- Esquire asks Does Football Really Matter? in its gridiron-heavy September issue.
- Mens **Health fact**: Football players routinely take hits greater than 13 times the force of gravity. Astronauts can black out when gravity … (Sun-Sentinel (Fort Lauderdale, FL, August 31, 1997);

What are the **health facts** that the EPA has hidden? First, while asthma has been rising, ground-level ozone rates have fallen dramatically over the past 20 … (The Washington Times, August 29, 1997);

The site offers details on how to find a dentist; dental **health facts**; a dental glossary; and an interesting essay titled … (The Houston Chronicle, July 20, 1997);

The Women's Hospital of Greensboro is offering a program from 6:30 to 8:30 p.m. July 29 to discuss common gynecological problems every woman should know about. "Intimate **Health Facts**" will present the latest information about these problems along with treatment options available. Discussion topics will include endometriosis, fibroid tumors, hysterectomy and sexually transmitted diseases. A gynecologist will lead the discussion and answer questions dealing with these issues. (News & Record (Greensboro, NC), July 13, 1997);

Test your knowledge of men's **health facts**: 1. What health threat is the biggest killer of men in the United States? In recent years, male deaths from … (Pittsburgh Post-Gazette, June 3, 1997);

… place, spend a week, maybe two, digging ditches, repairing roofs, caring for the sick, teaching basic **health facts** and

> witnessing your faith. But short-term mission trips are a part of summer for hundreds of Chattanoogans. They take … (The Chattanooga Times, May 24, 1997).

Applicant's software product, as set forth in the application's identification of goods, appears to be essentially a clinical and practice management tool for use by healthcare institutions and professionals. As applicant asserts at page 8 of its main brief:

> [a]pplicant's goods are computer software that specifically combines clinical data and claim based billing data with information from public sources. Such compilation and extraction of information allows the user to examine its performance in a context which allows for the identification of the best practices, guidelines and pathways to enable the user to make better clinical and management decisions.

The Trademark Examining Attorney argues that HEALTH FACTS is merely descriptive of the "subject matter" of applicant's software. "The goods allow for the input of factual health-related information in order to 'make better clinical and management decisions.' The subject matter in the instant case clearly describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods, i.e., facts pertaining to health-related information." (Brief at 12.) We do not agree.

Contrary to the Trademark Examining Attorney's assertion, the evidence of record does not demonstrate any use of HEALTH FACTS in connection with software of the type identified in the application, nor in connection with any similar type of clinical and practice management tool directed to healthcare professionals and institutions. In most, if not all, of the NEXIS® excerpts, "health facts" is used to refer to general-interest health information directed to consumers, and not to the type of "clinical data," "claims based billing data" and "data from public sources" which is the subject matter of applicant's software and which would be of specific interest to healthcare institutions and professionals. Thus, this evidence does not persuade us that applicant's mark is merely descriptive as applied to applicant's goods. *See In re The Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB 1994).

For the same reason, it is not particularly probative in this case that, with respect to the registration which is the subject of the Trademark Examining Attorney's Section 2(d) refusal (see *supra* at footnote 2), the registrant, Center for Medical Consumers and Health Care Information Inc., was required to resort to the Supplemental Register for registration of HEALTH FACTS for its "periodically published news sheet." The fact that

HEALTH FACTS was found to be merely descriptive of registrant's news sheet is not dispositive of the question of whether HEALTH FACTS is merely descriptive of applicant's goods in this case. *See In re The Stroh Brewery Co., supra* at 1797. We are not persuaded by the Trademark Examining Attorney's argument to the contrary.

In summary, we find that HEALTH FACTS does not describe any feature or aspect of applicant's software with sufficient particularity and directness to warrant a Section 2(e)(1) refusal. *Cf. In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988)(TECHNOLOGY too broad a term to be merely descriptive of applicant's particular goods). HEALTH FACTS certainly is not the strongest of marks, but we find that, as applied to applicant's goods, it falls on the suggestiveness side of the line, rather than on the mere descriptiveness side. To the extent that the Trademark Examining Attorney's evidence and arguments raise any doubt as to that question, we resolve that doubt, as usual, in favor of applicant. *See In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). We reverse the Section 2(e)(1) refusal.[5]

[5] Because applicant's application is based on intent-to-use, there are no specimens in the record demonstrating the nature of applicant's goods and the manner of use of the mark thereon. If, after applicant submits its specimens with its Statement of Use, it appears therefrom that applicant's goods are nothing more than

We also reverse the Trademark Examining Attorney's Section 2(d) reversal, which is based on the prior Supplemental Register registration of HEALTH FACTS for "periodically published news sheet." Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E.I. du Pont de Nemours and Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

In this case, we find that applicant's mark HEALTH FACTS is identical to the cited registered mark. Normally, when the applicant's mark is identical to the cited registered mark, that fact weighs substantially in favor of a finding of likelihood of confusion. However, in our likelihood of confusion analysis in the present case, the

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a compendium or recitation of "health facts" of the type described in the NEXIS® evidence, such new information might provide a basis for issuing a new Section 2(e)(1) refusal.

identity of the marks is essentially negated by the weakness of the registered mark HEALTH FACTS. Although a Supplemental Register registration may be a Section 2(d) bar to issuance of a subsequent Principal Register registration in appropriate cases, *see In re The Clorox Company*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978), we find that this is not such a case.

As noted by the Board in *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1533 (TTAB 1994), when the registration cited as a bar in a Section 2(d) refusal is a Supplemental Register registration, likelihood of confusion has normally been found only where the applicant's and the registrant's marks and goods are substantially similar. This is not because a different likelihood of confusion standard or analysis is applied in cases involving cited Supplemental Register registrations, but rather because marks registered on the Supplemental Register are in most cases merely descriptive or otherwise weak, and thus are entitled to a quite narrow scope of protection. *See In re The Clorox Company, supra; In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984) and cases cited therein; and *In re Hunke & Jochheim,* 185 USPQ 188 (TTAB 1975).

In this case, we find that applicant's goods and the goods identified in the cited Supplemental Register

registration are dissimilar enough that no confusion is likely to result from applicant's and registrant's uses of their respective HEALTH FACTS marks on their respective goods. We are not persuaded by the Trademark Examining Attorney's argument that applicant's goods are encompassed within, and thus legally identical to, the goods identified in the cited registration. As noted by the Trademark Examining Attorney, registrant's identification of goods does not limit registrant's news sheet[6] to any particular subject matter, so we presume that the news sheet could feature the same sort of clinical and practice management information that is provided and/or utilized by applicant's software. However, even if applicant's software and registrant's news sheet might pertain to the same subject matter, the products are nonetheless different in nature and application. A software program such as applicant's is an interactive management tool, while a news sheet such as registrant's is essentially a passive reference source.

Moreover, there is no basis in the record for concluding that purchasers would be likely to assume that applicant's software product and registrant's news sheet

[6] Webster's Third New International Dictionary (1993) defines "newssheet" by listing "newspaper" and "newsletter" as synonymous cross-references.

are merely alternative versions of each other (differing only as to the media in which they appear), or that they are complementary products emanating from a single source. There is no evidence that others in the industry offer both a news sheet and a software program as alternative, complementary, or otherwise related goods, or that purchasers would expect such goods to emanate from a single source.

In summary, applicant's and registrant's respective goods are not legally identical, as argued by the Trademark Examining Attorney, nor have they been shown to be the types of goods which are so related that they would be expected to emanate from a single source if they are marketed under the weak mark HEALTH FACTS.

Additionally, although we presume (from the absence of any restrictions in the cited registration's identification of goods) that registrant's news sheet and applicant's software could be marketed in the same trade channels and to the same classes of purchasers, we are persuaded by applicant's contention that the relevant purchasers, i.e., healthcare institutions and professionals, are sufficiently sophisticated that they are not likely to be confused if the encounter the weak mark HEALTH FACTS used on these

essentially different products. *Cf. In re Digirad Corp.*, 45 USPQ2d 1841 (TTAB 1998).

After careful consideration of all of the relevant du Pont evidentiary factors, we conclude that there is no likelihood of confusion in this case. Applicant's mark is identical to registrant's mark, but registrant's mark is not entitled to a scope of protection broad enough to preclude registration of applicant's mark for applicant's distinctly different and dissimilar goods.

Decision: The refusals to register under Trademark Act Section 2(e)(1) and 2(d) are reversed.